

MAR 05 2004

OFFICIAL

Attorney's Docket No. 740123-351

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Manfred PFALZGRAF

Application No.: 09/813,353

Filed: March 21, 2001

For: MOTOR VEHICLE ROOF WITH  
TWO COVERS

) RESPONSE UNDER 37 CFR 1.116

: EXPEDITED PROCEDURE

) EXAMINING GROUP 3612

:

) Examiner: D. Pedder

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office: Fax No. (703) 872-9306 on March 5, 2004.

  
K.M. McManus

REQUEST FOR RECONSIDERATION

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The comments are presented in response to the final Office Action mailed September 11, 2003, in connection with the above-captioned patent application.

With regard to the Examiner's continued objection to the drawings for failing to illustrate the details of the mechanism responsible for the claimed movements, since applicants continue to believe that 37 CFR § 1.83 does not require the illustration of unclaimed elements and that were only movements are recited, it is sufficient to merely diagrammatically depict same and the mechanism for producing such movements. Thus, since it appears that an impasse has been reached, applicants have Petitioned the Director via a contemporaneously filed Petition in order for the purpose of seeking acceptance of the drawings provided.

With regard to the Examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112 as failing to provide an adequate description of the invention, it continues to be

applicants position that one of ordinary skill in the art would not require a greater description than provided to be able to understand and practice the present invention. In support of this position, appended hereto is a Declaration of Bernd Scheicher which provides evidence as to fact that the person working in the art would require nothing more than has been disclosed in order to adapt conventional means to practice the present invention. Entry and consideration of this Declaration is in order in accordance with the decision of *In re Bulina and Brown*, 180 USPQ 110 (CCPA 1966). Furthermore, the Examiner is reminded of the points noted by the court in *In re Lange*, 209 USPQ 289, 294 (CCPA 1981) that:

the disclosure in question must be read in light of the knowledge possessed by those skilled in the art, and that knowledge can be established by affidavits of fact composed by an expert, [citations omitted] and by reference to patents and publications available to the public prior to appellant's filing date.

Here, applicants have provide evidence in the form of both prior patents and the Declaration of Bernd Schleicher which clearly demonstrate the knowledge possessed by those skilled in the art. Furthermore, while no known mechanism has shown which produces the exact same movements, the evidence demonstrates that the adaption of known technology for the production of the claimed movements was well within the skill in the art. In this connection, it is pointed out that, even if some experimentation might have been required to arrive at the correct mechanism, "it is only *undue* experimentation that is fatal" *In re Geerdes*, 180 USPQ 789, (CCPA 1974) citing *In re Smythe*, 178 USPQ 279 (CCPA 1973), and the Declaration of Bernd Schleicher "the mechanism as described can be easily implemented."

Accordingly, the Examiner is once again requested to reconsider and withdraw his rejection under the first paragraph of § 112, so that this application can proceed to issuance as a patent. However, in view of the impending expiration of the full six month statutory period, as precaution, a Notice of Appeal is being filed as well.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Lastly, it is noted that a separate Extension of Time Petition accompanies this response along with a check in payment of the requisite extension of time fee. However,

should that petition become separated from this Amendment, then this Amendment should be construed as containing such a petition. Likewise, any overage or shortage in the required payment should be applied to Deposit Account No. 19-2380 (740123-351).

Respectfully submitted,

By:



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